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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,334	05/03/2004	Rolf Sommer	65999-0001	1350

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EXAMINER

COSTALES, SHRUTI S

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,334

Applicant(s)

SOMMER, ROLF

Examiner

Shruti S. Costales

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/21/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on December 21, 2001 was filed in compliance with the provisions of 37 CFR § 1.97. Accordingly, the information disclosure statement filed by the applicant has been considered by the Examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference numeral 7 in one of FIGS. 1 or 2, wherein reference numeral 7 is mentioned in the description as pertaining to FIGS. 1 and 2 on page 9, paragraph [42]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy

must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Objections

3. Claims 46-48 are objected to because of the following informalities:
- (i) An "A" should be added before "Method" in line of claim 46 in order to provide a grammatically correct sentence.
 - (ii) A "The" should be added before "Method" in line 1 of claims 47 and 48 in order to provide a grammatically correct sentence and to avoid any problems arising from insufficient antecedent basis.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) More particularly, claim 27 recites that "the melting point of the printed film is in a range in which the printed film melts with the gel wax", wherein it is not clear to one of ordinary skill in the art which "range" is being referred to as a melting point is usually

one value and not a range of values. Claims 28-45 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

Claim 48 is rejected under 35 U.S.C. 112, second paragraph, for the same reasons as set forth above.

(b) Claims 28 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claims 28 and 39 recite "a correspondingly suitable plastic", wherein such phrase is not clear to one of ordinary skill in the art because it is unclear what is meant by "correspondingly suitable" and it is not clear what plastics are encompassed by this phrase.

(c) Further, claims 29, 30, and 35 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 29 recites that "the inlay is produced from a cellulose impregnated, coated or printed with additives", wherein it is not clear to one of ordinary skill in the art what is meant by "cellulose impregnated". It appears that some words are missing after "cellulose impregnated". Claims 30 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(d) Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 30 recites "the printing inks", wherein there is insufficient antecedent basis for this limitation in the claim. Claim 35 is

rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(e) Claims 31, 32, and 41 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claims 31 and 32 recite that the film is fixed adjacent and parallel to the wick in the gel wax, wherein it is not clear to one of ordinary skill in the art how it is possible that the film is both adjacent to and parallel to the wick. The term "adjacent" implies that the film is physically placed next to the wick such that there is some contact between the two, and the term "parallel" implies that the film is merely placed in the same planar direction as the wick without necessitating any contact between the film and wick. Further, it is not clear in claim 32 how it is possible for one printed film to be adjacent and parallel between two wicks. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(f) Claim 37 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 37 recites that a container is provided with "a structure on the inside or outside", wherein it is not clear to one of ordinary skill in the art how a container is being provided that is capable of providing a structure on the inside or the outside with respect to an unidentified object.

(g) Claims 40 and 42-44 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. More particularly, claim 40 recites "a clearance over a certain area", wherein "a certain area" is indefinite to one of ordinary skill in the art as no definition is provided to determine what is meant by "a certain area".

Further, with respect to claim 40, it is not clear to one of ordinary skill in the art what is meant by "vicinity" and how close the body is to the surface to be in the "vicinity" of the surface. Therefore, the recitation of "vicinity" renders claim 40 indefinite.

Additionally, with respect to claim 40, it is not clear what is meant by "approximately" because it is not possible to determine what the height of the body is in order to "approximately" correspond to the depth of a pool of wax. The recitation of "approximately" therefore renders claim 40 indefinite.

Also, with respect to claim 40, it is not clear what is meant by the recitation "the inlay is arranged as a body" because it is not possible to determine how a printed film is arranged as an undefined "body". The recitation of "the inlay is arranged as a body" therefore renders claim 40 indefinite.

Claims 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(h) Claims 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 38 recites that the inlay is "prismatic", wherein it is not clear to one of ordinary skill in the art how a printed film may be prismatic. Further, claim 38 recites a "specially shaped body" wherein such

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phrase is not clear to one of ordinary skill in the art because it is not clear what is meant by "specially". Claim 39 is also rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(i) Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claims 38 and 41 recite "the body". There is insufficient antecedent basis for this limitation in the claims.

(j) Claims 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 46 recites "placing a wick in an aligned manner on or in the inlay", wherein it is not clear to one of ordinary skill in the art how one is place a wick that both aligned and placed on or in the inlay. Claims 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 27-28, 30-35, 37-39 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (U.S. Patent Number 6,435,694) in view of Carpenter et al. (U.S. Patent Number 6,554,448) and Elliott III et al. (U.S. Patent Number 6,471,731).

Bell, which is drawn to decorative candles (Col. 1, lines 8-9) and a process for making such candle (Col. 5, lines 16-20), discloses a candle having an outer portion and an inner portion both made of clear gel and the inner portion has at least one wick and the outer portion has a variety of decorative objects (Col. 2, lines 25-67). The gel remains clear over extended periods of time and does not coke during burning (Col. 3, lines 66-67 and Col. 4, lines 1-4), therefore the gel is intrinsically a gel wax. Bell also discloses that as the wick burns down, the gel in the inner portion is consumed (Col. 5, lines 7-10), leading one of ordinary skill in the art to logically conclude that the melting point of the wick is intrinsically higher than that of the gel wax so that the candle can be used as intended.

The difference between Bell and the presently claimed invention is (a) an inlay that is designed as a printed film and the printed film melts with the gel wax as the wick burns down, and (b) the inlay is disposed within the gel.

With respect to the difference in (a), on the one hand, Bell discloses a variety of decorative objects and does not limit these decorative objects to silk leaves, crystals, stones, and glitter (Col. 4, lines 5-17). It would have been obvious to one of ordinary skill in the art to use a printed film inlay as one of the decorative objects in Bell as it would allow for three-dimensional decorative effects and multi-layered decorative effects (Col. 4, lines 14-17). On the other hand, Carpenter, which is drawn to candle products decorated by the application of a decorative film having temperature sensitive properties (Col. 1, lines 15-20), discloses that a heat-shrinkable polymer wrap may be applied directly to a candle, wherein the polymer wrap constitutes a film upon which thermochromic ink may be deposited in a random manner or a desired pattern (Col. 8, lines 53-67 and Col. 9, lines 1-7). Carpenter also discloses that the polymer wrap is made of polyethylene (Col. 10, lines 3-27), therefore it would intrinsically melt with the gel wax and intrinsically be transparent as polyethylene is one of the materials recited in the presently cited claims that forms the inlay. It would have been obvious to one of ordinary skill in the art to use Carpenter's decorative film printed with ink in Bell's decorative objects because the appearance of the candle will be improved (Col. 9, lines 8-10).

With respect to the difference in (b), Bell discloses that the decorative objects are dispersed throughout the candle (Col. 3, lines 5-8), therefore the dispersion of the

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decorative objects in the candle is not limited to the exterior surface of the candle.

However, there is no explicit disclosure of embedding the decorative objects in the wax.

Elliott, which is drawn to a polymeric candle composition (Col. 1, lines 13-15), discloses that ornamental features such as messages may be embedded within candles (Col. 7, lines 59-67 and Col. 8, lines 1-30), intrinsically includes any geometric shape of such ornamental features within the candle. Given that there is no limitation on where the messages are embedded in the candle, it is clear that the messages can be embedded anywhere including adjacent and parallel to the wick or adjacent and parallel between two wicks. Elliott also discloses colored wicks (Col. 7, lines 35-39).

It would have been obvious to one of ordinary skill in the art to use the printed decorative film of Carpenter in Bell's candle and suspend it within the gel as disclosed by Elliott because the polymeric wrap with an inked message would act as a decorative object in Bell's candle (Col. 7, line 64), thereby obtaining the invention as set forth in the presently cited claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DE 29917826 U1, which is cited as an "X" reference in the International Search Report for the corresponding PCT application, discloses a candle having gel wax, however, this document is not applicable against the present claims because DE 29917826 U1 is a 102(a) reference based on publication date, but cannot

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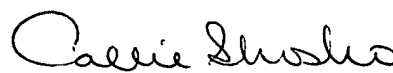
be utilized because DE 29917826 U1 has the same inventive entity as the present application, and thus is not to "another".

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

SSC
Shruti S. Costales
July 20, 2005


CALLIE E. SHOSHO
PRIMARY EXAMINER